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10/028,888	12/19/2001	Jeffrey G. Nowlin	020375-006500US	2318
20350	7590		EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP		WOO, RICHARD SUKYOON		
TWO EMBARCADERO CENTER		ART UNIT		
EIGHTH FLOOR		3629		
SAN FRANCISCO, CA 94111-3834		PAPER NUMBER		

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Please find below and/or attached an Office communication concerning this application or proceeding.



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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

Application Number: 10/028,888
Filing Date: December 19, 2001
Appellant(s): NOWLIN et al.

OCT 26 2004

GROUP 3600

Jeffrey G. Nowlin et al.

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 30, 2004

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that all pending claims, i.e. claims 1, 2, 6 through 16, 18 through 22, and 27 through 35, are considered by Appellant as a single group. Accordingly, it is deemed to be true that claims 1, 2, 6 through 16, 18 through 22, and 27 through 35 stand or fall together.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

EP 0,621,563 A1 Long

10-1994

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Because claims 1, 2, 6 through 16, 18 through 22, and 27 through 35 stand or fall together, the examiner's ground of rejection has been directed to the broadest one of the appeal claims, i.e. Claim 15 in this instant appeal.

Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Long (EP 0,621,563).

W.R.T. Claim 15:

Long discloses a system for producing and weighing mailing units, comprising:
a controller having a processor and a memory containing the weight of each of the components (predetermined) (see Fig. 2; also Supra Claim 1);
a printer (as controlled by the controller 25) for printing an identifier (information to identify a person; credit card number or driver's license number) on a section of the traveling web of paper (see abstract and col. 2, line 55 – col. 3, line 4; col. 4, lines 32-40);
a reader (27, 66) for reading the identifier and providing the identifier to the controller;

a movable track (see Figs. 1a-2);
a plurality of inserting locations, a plurality of inserting mechanisms (see Fig. 1b);
a moving mechanism to move the inserts from the track and into an envelope
(see Id.); and
wherein the controller determines the components of the mailing unit based on
the identifier (see Fig. 2; the reader 27, 66 scans the identifier) and the weight of the
mailing unit based on the weights of the components (for example, col. 5, lines 43-56;
col. 6, line 51 –col. 7, line 5).

(11) Response to Argument

In response to appellant's argument that **Long** does not disclose each and every
element in the independent Claim 15, the examiner respectfully traverses.

Long discloses a system comprising: a controller having a processor and a
memory containing the weight of each of the components (predetermined) (Fig. 2;
databases 88, 90); a printer (as controlled by the controller 25) (see abstract and col. 2,
line 55 – col. 3, line 4; col. 4, lines 32-40); a reader (27, 66); a movable track (see Figs.
1a-2); a plurality of inserting locations, a plurality of inserting mechanisms (see Fig. 1b);
and a moving mechanism.

In response to applicant's argument that the printed identifier or information in
Long referenced by the examiner is clearly not printed **in order to** later identify
components of the mailing unit and, conversely, the appellant's printer prints after that
one of the components has been provided to system **in order to** identify the
components of the mailing unit, a recitation of the intended use of the claimed invention

must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). It is respectfully noted by the examiner that the identifier (information in a data record) in **Long** is used to determine which inserts should be stuffed into an envelope and an indication of the weight of the envelope with enclosures, based on the known weight of the envelope, card and letter sheet and the known weights of the selected inserts. Therefore, the system of **Long** can identify the components of the mailing unit based on its identifier and reading thereof, as claimed by the appellant.

Accordingly, **Long** structure is capable of performing the intended use the prior art structure is capable of performing the intended use, then it meets the claim 15.


For the above reasons, it is believed that the rejections should be sustained.


Application/Control Number: 10/028,888
Art Unit: 3629

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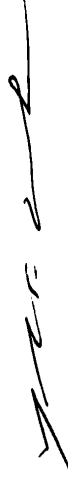
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Respectfully submitted,



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